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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,857	05/14/2001	Lance E. Brothers	HES 99.0350U1C1	1002

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05/28/2003

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

18

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,857

Applicant(s)

BROTHERS ET AL.

Examiner

Paul Marcantoni

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1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/20/03 (RCE filing).
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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Applicant's RCE and response filed 5/20/03 have been fully considered but they are not persuasive.

35 USC 103 Rejection:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-40 remain rejected under 35 U.S.C. 103(a) as obvious over Reddy et al. (US 6,273,191B1) alone or in view of Cowan et al. '991 or Gilbert et al. '866.

Reddy et al. teach cement composition comprising calcium aluminate cement, accelerator, retarder, water, as well as foam forming and foam stabilizing surfactants thus anticipating the instant invention. Even if not anticipated, Reddy would appear to teach the same components in overlapping amounts. Cowan et al. and Gilbert et al. would appear to teach that the use of lithium salts as accelerators for aluminous cements including those used for subterranean formations would have been obvious to one of ordinary skill in the art. Note that in column 7, first paragraph Reddy et al. teach that a variety of cement set accelerators may be used, calcium salt accelerators such as calcium chloride, calcium nitrite, and calcium formate are preferred. A reference, however, is good for all that it realistically teaches and is not limited to the preferred embodiments. Lithium salts were known at the time of applicants' invention for use in subterranean formations and for aluminous cements and the use of other known or

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conventional accelerators in the Reddy et al. cement composition would have been obvious to one of ordinary skill in the art because they were known accelerators for subterranean formations at the time of applicants invention.

Cowan et al. also teach that the set retarder for ^{cement}~~ement~~ can be gluconic acid, tartaric acid, and hydroxycarboxylic acid (e.g. citric acid) which meets the limitations of the claimed invention.

Response:

The applicants have limited their invention or claimed cement composition to "consisting essentially of" claim language. The applicants argue that because Reddy teaches using low amounts of calcium aluminate cement in the range of 0.5 to 5 wt%

In rebuttal, when applicants contends that the modifying components in the reference are excluded by the recitation of "consisting essentially of", applicants have the burden of showing the basic and novel characteristics of their composition – i.e. a showing that the introduction of these components would materially change the characteristics of the applicants' composition. In re Delajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964).

It is the examiner's position that while the additional hydraulic cement (ie Portland cement or equivalent cement) is the cement present in the greatest amounts in Reddy '191 B1, the applicants have not shown that the presence of this additional hydraulic cement would materially change the characteristics of the applicants' composition. Absent this showing, the applicants' arguments are not convincing.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Paul Marcantoni
Primary Examiner
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